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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,843	08/20/2001	Anthony J. Baerlocher	0112300-898	9181

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 07/30/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No. 09/933,843	Applicant(s) BAERLOCHER ET AL.	
	Examiner Binh-An D. Nguyen	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 6-22 and 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 23, 24 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The Information Disclosure Statement, Affidavit Under 37 C.F.R. 1.131, and the Amendment filed in Papers No. 7-9, respectively, May 1st, 2003 have been received. According to the Amendment, claims 1, 6-9, 13-16, and 20-30 have been amended. Acknowledgment has been made.

2. Applicants' request for reconsideration of the restricted generic claims (claims 23, and 29-31) during the interview of March 11, 2003 (see Paper No. 6) has been found persuasive. Further, upon reconsideration, claims 6 and 8 have been found to belong to Species C (Figures 3C, 3D, and 5, enabling a player to associate digits with selections); and claim 7 has been found to belong to Species A (Figures 3A and 3B, player manually rearranging masked digits), therefore, claims 6-8 are hereby withdrawn from consideration. Note, claims 9-22 and 25-28 are also withdrawn from consideration as being directed to non-elected species, Paper No. 4. See 37 CFR 1.142(b) and MPEP § 821.03. Thus, claims 1-5, 23, 24, and 29-31 are hereby examined on the merit.

3. The disclosure is objected to because of the following informalities:

The disclosed co-pending applications should be updated with granted Patent numbers. Appropriate correction is required.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 23, 24, and 29-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rose (6,589,114).

Rose teaches a system and method for modifying an award comprising: a display device (12); an original award (first award) having a plurality of digits displayed by the display device (Fig. 4), said original award (first award) resulting from a gaming event played by a player and wherein the digits indicate an amount of the original award (first award); a processor (18) communicates with the display device (12)(2:38-52), and rearranges the digits of the original award (first award) causing the display device to display said rearranged digits and providing a modified award (second award)(Fig. 6) to a player wherein the rearranged digits indicate the amount of the modified award (second award)(4:1-26); said arrangement of said digits is one of a plurality of modifiers

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of said digits; a modify input which communicates with the processor, wherein the digits are arranged upon a player's selection of the modify input (4:27-52); the processor rearranges the digits when an expected value associated with the digits in the original award exceeds the original award (4:55-57); the processor randomly determines when to rearrange the digits based on a probability stored in a memory device accessed by the processor (4:49-57). See also the entire reference.

Note that, Rose does not explicitly teach the limitations of gaming device comprising a plurality of different award modification methods; a player selectable award modify input which communicates with the processor; and an activation which initiates one of the selected award modification methods (claims 23 and 29), these limitations, however, are inherently known from the gaming industry, i.e., new features and themes for bonus games (1:11-49).

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Rose's award modification system and method by adding more award modification features and themes to video gaming to provide more attractive gaming and excitement to game players.

7. The declaration filed on May 1st, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Rose (6,589,114) reference.

8. The Rose (6,589,114) reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An

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affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the patent may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.


9. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

BN
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JESSICA HARRISON
PRIMARY EXAMINER